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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PHILPOTT, JUSTIN M	

ART UNIT	PAPER NUMBER
2665	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/323,135	LAROQUE ET AL.	
	Examiner	Art Unit	
	Justin M. Philpott	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 11-13* is/are rejected.

7)☒ Claim(s) *9 and 10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 14-15, filed March 2, 2005, with respect to claims 9 and 10 have been fully considered and are persuasive. The rejection of claims 9 and 10 has been withdrawn, and claims 9 and 10 are presently objected to as comprising allowable subject matter for reasons discussed in the following office action.

2. Applicant's arguments filed March 2, 2005 with respect to claims 1, 2, 12 and 13 have been fully considered but they are not persuasive.

First, applicant argues (pages 6-7) that all of the limitations of applicant's claims 12 and 13 are enabled by applicant's Figure 2 and its corresponding description on pages 6-8 of the specification. However, with this argument, applicant is requesting Examiner to impermissibly read limitations into applicant's claimed invention which simply are not disclosed in applicant's invention as originally filed. That is, the specification is completely void of any phrasing, or similar language or figures which indicate, that at the time of the invention, applicant contemplated the limitations of claims 12 and 13 wherein replacement of a flag occurs "regardless of the destination for the signaling message" (claim 12) or "regardless of the signaling configuration of said signaling message" (claim 13). In applicant's argument, applicant points to Figure 2, and generally states reference is made to pages 6-8 of the specification, however, this figure and the general description simply do not teach such a specific

limitation as recited in the claims. Accordingly, claims 12 and 13 remain rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement.

Second, applicant argues with respect to claim 1, generally, (pages 7-12) that Hickey does not teach: (a) more than one type of signaling channels are available, or (b) producing signaling configuration based on the type of signaling channels.

With respect to part (a), such a limitation is not recited in applicant's claim. A plurality of the same type of signaling channels (e.g., a plurality of D-channels in Hickey) clearly meets the broad language of applicant's claim 1 reciting "type of signaling channels accessible". Thus, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a plurality of types of signaling channels) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, part (a) is not persuasive.

Further, regarding part (b), clearly, the D-channel signaling messages of Hickey (col. 3, lines 31-34) depend upon the signaling channels being D channels. Hickey specifically recites, "[a]n incoming call is presented as a D channel message to the network interface 42 which passes the D channel message through the signaling channel 46" (col. 3, lines 31-34). Thus, the D channel signaling message of Hickey clearly depends upon the channel to be a D channel. Accordingly, part (b) of applicant's argument is not persuasive.

Alternatively, if applicant has intended to argue that applicant's invention is distinguishable from Hickey because applicant's invention comprises one of a plurality of types

of signaling channels, and that a signaling configuration is selected based upon which of the plurality of types of channels are accessible to the coupler, it is noted that the broad language of applicant's claim 1 does not recite such an invention. On the contrary, Hickey teaches the broad limitations of claim 1, and as discussed above, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, applicant's argument remains unpersuasive. However, if the above-mentioned limitations, not presently recited in applicant's claims, do in fact accurately describe applicant's invention as originally filed, applicant is encouraged to amend the claims to accurately reflect applicant's invention.

Third, applicant argues with respect to claim 1, more specifically, (page 11, second paragraph) that Hickey does not teach having a transcoder for each of a plurality of types of signaling messages, or a non-uniform network where transcoders may need to be used. However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a transcoder for each of a plurality of types of signaling messages, or a non-uniform network where transcoders may need to be used) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, applicant's argument is not persuasive.

Fourth, applicant argues with respect to claim 2 (page 14, first paragraph) that a detection step in Kabay is unnecessary. However, as recited in MPEP 2144, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by

applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Dillon, 919 F.2d 688, 15 USPQ2d 1897 (Fed. Cir. 1990). Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). Kabay teaches the limitations recited in dependent claim 2 as discussed in the previous office action, and repeated herein. Thus, applicant's argument is not persuasive.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, claim 12 recites the limitation "regardless of the destination for the signaling message" and claim 13 recites the limitation "regardless of the signaling configuration of said signaling message". Neither of these limitations are enabled by applicant's specification.

Applicant may overcome this rejection by amending the claims to remove the above limitations. However, as amended, claims 12 and 13 would be objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, claim 2. Thus, claims 12 and 13 should be canceled.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,995,595 to Hickey et al.

Regarding claim 1, Hickey teaches a switch (e.g., ISDN telephone 12/14, see FIG. 1) comprising: a coupler (e.g., comprising network interface 42, see FIG. 3) accessing signaling channels (e.g., D-channels; signaling channel 46) to transmit signaling messages (e.g., message signaling via signaling packets, see col. 3, lines 8-42); an interpreter (e.g., CPU 40 in combination with ROM/RAM 52/54, see col. 3, lines 22-64) producing a signaling configuration (e.g., setup message, see col. 3, line 43 – col. 4, line 5) upon receiving an order to send a signaling message (e.g., an incoming call when in remote mode, see col. 3, lines 55-64), the signaling configuration produced (e.g., setup message) depends on a type of the signaling channels accessible to the coupler (e.g., setup message depends on the signaling channel

comprising a D-channel, see col. 3, lines 63-64); and a receiver (inherently within 12/14) for adding a receive flag (e.g., flag or code, see col. 4, lines 1-3) to a received signaling message, wherein the order (e.g., incoming call) is a predetermined constant character string (e.g., calling line ID, see col. 3, line 42 – col. 4, line 5).

Regarding claim 3, Hickey teaches a switch as discussed above regarding claim 1, wherein the switch provides a method of sending a signaling message (e.g., message signaling via signaling packets, see col. 3, lines 8-42), comprising: adding to the signaling message a predetermined send order for the signaling message (e.g., an incoming call when in remote mode, see col. 3, lines 55-64), the adding further comprises the switch receiving the signaling message in a receiving exchange (e.g., see col. 3, line 22 – col. 4, line 5) and adding a receive flag (e.g., flag or code, see col. 4, lines 1-3) to the signaling message; and interpreting the send order in an interpreter (e.g., CPU 40 in combination with ROM/RAM 52/54, see col. 3, lines 22-64) of the switch to produce a signaling configuration (e.g., setup message, see col. 3, line 43 – col. 4, line 5) of the switch, the signaling configuration (e.g., setup message) produced depends on a type of signaling channels available to the switch (e.g., setup message depends on the signaling channel comprising a D-channel, see col. 3, lines 63-64), wherein the receive flag is a specified constant (e.g., flag or code, see col. 4, lines 1-3) and the predetermined send order (e.g., incoming call) is a specified constant character string (e.g., calling line ID, see col. 3, line 42 – col. 4, line 5).

Regarding claims 5 and 7, Hickey teaches the interpreter is configured, and comprises a circuit, to process at least a switched X25 protocol (e.g., see col. 1, lines 15-62).

Regarding claim 8, Hickey teaches the interpreter comprises one of a microprocessor associated with a program, and a working session in a processor running the switch (e.g., via CPU 40 in combination with ROM/RAM 52/54, see FIG. 3 and col. 3, lines 22-42).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2, 4, 6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey in view of U.S. Patent No. 5,949,871 to Kabay et al.

Regarding claims 2 and 4, Hickey teaches the switch and method discussed above regarding claims 1 and 3, however, may not specifically disclose a detector or translator.

Kabay also teaches a switch and a method for telecommunications, and specifically, teaches a coupler (e.g., intercept box) has a detector (e.g., implicitly done by database lookup) for recognizing whether a received signaling message is addressed to a switch (e.g., see col. 17, lines 12-15), and implicitly processing the message accordingly when the switch is the destination, and a translator (implicitly via the database operation) for replacing the receive flag (e.g., comprising location routing number, or LRN) with a predetermined character string (e.g., dialed number, or CdPN) when the switch is not the destination for the signaling message (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers). The teachings of Kabay provide the implementation of improved services in a

switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Regarding claim 6, as discussed above regarding claim 8, Hickey teaches the interpreter comprises one of: a microprocessor associated with a program, and a working session in a processor running the switch (e.g., via CPU 40 in combination with ROM/RAM 52/54, see FIG. 3 and col. 3, lines 22-42).

Regarding claim 11, Hickey teaches when the signaling message is received by the switch, adding a receive flag (e.g., flag or code, see col. 4, lines 1-25) to the signaling message and checking the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message (e.g., see col. 4, lines 1-25 wherein upon detection of a flag, it is determined whether the call is from WAW telephone 12 and is correspondingly to be received by a WAW telephone such as WAW telephone 14).

Regarding claims 12 and 13, as discussed above regarding claim 2, Kabay teaches a translator (via database operation) for replacing the receive flag (e.g., comprising location routing number, or LRN) with a predetermined character string (e.g., dialed number, or CdPN) if the switch is not itself the destination (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers), regardless of the signaling configuration or signaling message destination. The teachings of Kabay provide the implementation of

improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Allowable Subject Matter

9. Claims 9 and 10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: claim 9 comprises allowable subject matter the for reasons argued by applicant on pages 14-15 in the Remarks filed March 2, 2005; and claim 10 is dependent upon claim 9 and therefore comprises allowable subject matter for the same reasons as discussed above regarding claim 9.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Philpott whose telephone number is 571.272.3162. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on 571.272.3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Justin M Philpott

ALPUS H. HSU
PRIMARY EXAMINER